

## **REMARKS<sup>1</sup>**

In the outstanding Office Action, the Examiner made the following rejections:

- 1) Claims 1, 2, 4, 5, 7, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,388,571 to Lowles et al. (*Lowles*);
- 2) Claims 6 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Lowles*;
- 3) Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Lowles* in view of U.S. Patent No. 4,224,615 to Penz (*Penz*);
- 4) Claims 8 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Lowles* in view of U.S. Patent No. 4,136,291 to Waldron (*Waldron*);
- 5) Claims 9-11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over *Lowles* in view of U.S. Patent No. 4,910,504 to Eriksson (*Eriksson*); and
- 6) Claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Lowles* and *Eriksson* in view of U.S. Patent Application Publication No. 2005/0270273 to Marten (*Marten*).

By this Amendment, Applicant cancels claims 2 and 3 without prejudice or disclaimer. Applicant also amends claims 1, 9, and 10. Claims 1 and 4-17 are now pending in this application.

### **I. Rejection Under 35 U.S.C. § 102(e)**

The rejection of canceled claim 2 is moot.

Applicant respectfully traverses the Examiner's rejection of claims 1, 4, 5, 7, and 16 under 35 U.S.C. § 102(e). In order to anticipate Applicant's claimed invention under

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<sup>1</sup> As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

35 U.S.C. § 102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." MPEP § 2131, 8th Ed., Rev. 7 (July 2008). *Lowles* cannot anticipate claims 1, 4, 5, 7, and 16, because *Lowles* fails to disclose each and every element recited in the claims.

For example, *Lowles* fails to disclose a combination including "the switching means is configured to preserve the voltage value between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate when the switching means is in the second state of operation," as recited in amended claim 1.

*Lowles* discloses "[w]hen a force is applied to the surface of the top glass substrate 104, such as a press with a finger or stylus, the distance between the top and bottom glass substrates 104, 118 changes and thus changes the distance between the strips of ITO electrodes 108, 116," wherein "[w]hen the distance between the electrodes changes, the capacitance of the pixel changes and the change in capacitance can be detected by the resulting change in voltage at that pixel." *Lowles*, col. 3, lines 43-50. *Lowles* further discloses switches 405 and 407 which are opened and closed to connect or disconnect pixels on a segment line to a driver 402 in response to a signal from logic controller 410. To the extent that switches 405 and 407 of *Lowles* can reasonably be construed as corresponding to Applicant's claims "switching means," *Lowles* does not

disclose, or even suggest, that switches 405 and 407 “preserve the voltage value between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate when the switching means is in the second state of operation,” as recited in amended claim 1 (emphasis added).

Consequently, amended claim 1 is allowable over *Lowles*, and claims 4, 5, 7 and 16 are allowable at least due to their dependence from claim 1. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 1, 4, 5, 7, and 16 under 35 U.S.C. § 102(e).

## **II. Rejections Under 35 U.S.C. § 103(a)**

The rejection of canceled claim 3 is moot.

Applicant respectfully traverses the rejection of claims 6, 8-15, and 17 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established based on the applied references. The Examiner has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See MPEP § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

### **A. Claims 6 and 15**

Claims 6 and 15 depend directly or indirectly from claim 1, and therefore require all of the elements recited in claim 1. As discussed above, *Lowles* fails to disclose or suggest a combination including “the switching means is configured to preserve the voltage value between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate when the switching means is in the

second state of operation,” as recited in amended claim 1, and required by claims 6 and 15. The Examiner has failed to provide any additional rationale or identify any further teaching of *Lowles* which cures this deficiency. Accordingly, claims 6 and 15 are allowable at least due to their dependence from claim 1. Applicant therefore respectfully requests that the Examiner withdraw the rejection of claims 6 and 15 under 35 U.S.C. § 103(a).

B. Claims 8 and 17

Claims 8 and 17 depend from claim 1, and therefore require all of the elements recited in claim 1. As discussed above, *Lowles* fails to disclose or suggest a combination including “the switching means is configured to preserve the voltage value between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate when the switching means is in the second state of operation,” as recited in claim 1, and required by claims 8 and 17. *Waldron* fails to cure the deficiencies of *Lowles*.

The Examiner cites to *Waldron* for allegedly disclosing “a touch sensor, wherein segments not connected to the signal generator (disabled condition, col. 3, lines 25-63) are retained in a high-ohmic state.” Office Action, page 6. Such alleged teachings, even if combinable with *Lowles*, fails to cure the deficiencies of *Lowles*. That is, *Waldron* also fails to disclose or suggest a combination including “the switching means is configured to preserve the voltage value between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate when the switching means is in the second state of operation,” as recited in claim 1, and

required by claims 8 and 17. In fact, *Waldron*, which merely discloses a transmitting electrode and a receiving electrode, is not even related to touch displays.

Accordingly, claims 8 and 17 are allowable at least due to their dependence from claim 1. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 8 and 17 under 35 U.S.C. § 103(a).

C. Claims 9-11 and 13

Claim 9 recites a combination including "the at least one display electrode on the second substrate is connected such that a voltage level between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate is preserved." For at least the reasons presented above with respect to claim 1, *Lowles* fails to disclose or even suggest the claimed combination. *Eriksson* fails to cure the deficiencies of *Lowles*.

*Eriksson* discloses "[o]n touch, eg by the operator placing a finger F on the front window 1, this capacitance value is changed by DC," wherein "[t]his change DC can be sensed by the detection circuit 9, which is connected to the pins 3', 4' similarly intended for driving the display device." *Eriksson*, col. 4, lines 5-10. *Eriksson*, however, provides no disclosure or suggestion of "the at least one display electrode on the second substrate is connected such that a voltage level between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate is preserved," as recited in amended claim 9.

As explained above, the elements recited in amended claim 9 are neither taught nor suggested by the applied references. Nor has the Examiner explained how teachings of the references could be properly modified to achieve the claimed

combination. Consequently, the Office Action has neither properly determined the scope and content of the prior art, nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in the art in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 9.

For at least the foregoing reasons, claim 9 is allowable over the applied references. Applicant, therefore, respectfully requests that the Examiner withdraw the rejection of claim 9 under 35 U.S.C. § 103(a), and allow claim 9. Further, claims 10, 11, and 13 depend from claim 9, and therefore require all of the elements recited in claim 9. Consequently, claims 10, 11, and 13 are allowable over the cited references for at least the same reasons as claim 9. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 9-11 and 13 under 35 U.S.C. § 103(a).

#### D. Claims 12 and 14

Claims 12 and 14 depend from claim 9, and therefore require all of the elements recited in claim 9. As discussed above, *Lowles and Eriksson* fail to disclose or suggest a combination including “the at least one display electrode on the second substrate is connected such that a voltage level between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate is preserved,” as recited in claim 9, and required by claims 12 and 14. *Marten* fails to cure the deficiencies of *Lowles and Eriksson*.

The Examiner cites to *Marten* for allegedly disclosing “a method, wherein the electrical coupling comprises a galvanic coupling.” Office Action, page 9. Such alleged

teachings, even if combinable with *Lowles* and *Eriksson*, fail to cure the deficiencies of *Lowles* and *Eriksson*. That is, *Marten* also fails to disclose or suggest a combination including "the at least one display electrode on the second substrate is connected such that a voltage level between the at least one display electrode on the first substrate and the at least one display electrode on the second substrate is preserved," as recited in claim 9, and required by claims 12 and 14.

Accordingly, claims 12 and 14 are allowable at least due to their dependence from claim 9. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claims 12 and 14 under 35 U.S.C. § 103(a).


In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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